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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,553	03/23/2001	Wendy Rodriguez	41556/04092 (RS11P053)	9493
22428	7590	05/24/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			NGUYEN, CUONG H	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,553

Applicant(s)

RODRIGUEZ ET AL.

Examiner

CUONG H. NGUYEN

Art Unit

3625

MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5_8_10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the IDS received on 6/17/2003.
2. Claims 1-18 are pending in this application.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

3. Claims 7, 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as recited in these claims is merely an abstract idea that is not within the technological arts. Mere abstract ideas that do not apply, involve, use the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter [see *Bowman* (BPAI), 61 USPQ2d 1669, 6/12/2001].

Even mere recitation in the **preamble or mere suggestion** in the claim that a machine is performing some or all of the steps in the method is NOT ENOUGH to place claimed invention in the technological arts. The body of the claim must unambiguously recite that a machine/apparatus is performing the step(s) and/or

is integrally involved in the process (i.e., a computer-implemented method) for the achieved effect (i.e., level of involvement, use, or advancement).

4. Practical Application in the Technological Arts:

When an invention is reduced to a practical application in the technological arts, the invention is statutory. Therefore, the claimed invention must produce a "useful, concrete and tangible result" (the pending claims satisfy this requirement); and the claimed invention must utilize technology in a non-trivial manner (i.e., the claim MUST include a limitation in the technological arts that enables a useful, concrete, and tangible result.

The phrase "technological arts" is synonymous with the phrase "useful arts" as it appears in Article I, Section 8 of the Constitution, In re **Waldbaum**, 173 USPQ 430 (CCPA 1972). For a claim to be statutory, it must be in the technological arts. In re **Musgrave**, 167 USPQ 280 (CCPA 1970) and In re Johnston, 183 USPQ 172 (CCPA 1974).

The technological arts inquiry must focus on whether the claimed subject matter is statutory. In re **Toma**, 197 USPQ 852 (CCPA 1978). In that case, **Toma** held "that the method of enabling a computer to translate natural languages in the technological arts, i.e., it is a method of operating a machine".

5. Claims 7, 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims are directed to a computer program product per se. There is no medium, apparatus or method steps involved. It represents an abstract idea as it is not tangibly embodied and merely represents non-functional data on a storage device (e.g., claimed program codes are written in a text book). There is no technological arts involved. Even if a medium were present, e.g. a floppy disk or a paper, the claimed program instructions are non-functional data with respect to any device such as a computer for performing a function, and those claimed codes would not have any functional relationship to the medium.

6. About claiming a "System" for independent claim 7, comprising "logic".

Although the claim is said to be a "system", the body of the claim is directed to software per se, (i.e. "logic" is intended to perform the functions). This claim is non-statutory for being directed only to functional descriptive material per se.

Claim Objections

7. Claims 8-12, 14-18 are objected for incorporating a defect from parent claims 7, 13 by dependencies.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a), which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negative by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. §103(a) are rejected under 35 U.S.C. §103(a) as being unpatentable over Fogel et al. (US Pat. 6,542,905), in view of Storey (US Pat. 5,774,870).

Fogel et al. teach a method for operating a supply chain management framework using a network; a server collects data from stores of said supply chain.

Fogel et al. do not expressly disclose about utilizing online order form, and an online catalog for orderings.

Storey further teaches about using an electronic order form and a virtual catalog by a customer to facilitate of ordering goods.

It would be obvious for one with ordinary skill in the art to implement Fogel et al.'s teachings with Storey's idea because artisans already recognize that utilizing an online order form and an online catalog to facilitate of ordering goods are old and well-known to increase convenience for customers in online orderings.

9. Claims 2-3 are rejected under 35 U.S.C. §103(a) are rejected under 35 U.S.C. §103(a) as being unpatentable over Fogel et al. (US Pat. 6,542,905), in view of Storey (US Pat. 5,774,870), and further in view of Dudle et al. (US Pat. 5,570,291).

The rationales and references for an obvious rejection of claim 1 are incorporated.

Fogel et al., and Storey do not expressly disclose about displaying raw products and distributors in an online catalog.

However, Dudle et al. suggest that idea (see Dudle et al., Fig.2 refs. 104, 108; Fig.3, ref. 117, 8:28-41), Dudle et al. also teach that a data collection system 108 collecting data relating to required material, that including a source to supply those required materials (see Dudle et al., 8:28-41).

It would be obvious for one with ordinary skill in the art to implement Storey and Fogel et al.'s teachings with Dudle et al.'s ideas because artisans already recognize that a catalog's information would be helpful if all required material for producing that product are included. It would be helpful to facilitate of ordering goods because this claimed limitation is old and well-known to increase convenience for customers in online orderings.

10. Claims 4-6 are rejected under 35 U.S.C. §103(a) are rejected under 35 U.S.C. §103(a) as being unpatentable over Fogel et al. (US Pat. 6,542,905), in view of Storey (US Pat. 5,774,870), and further in view of Dudle et al. (US Pat. 5,570,291), and the Official Notice.

The rationales and references for an obvious rejection of claim 3 are incorporated.

The Official Notice is taken here that Washington Post daily newspaper, new car section, e.g. "Nut and Bolt", teaches about advantages and disadvantages from different cars made by different manufacturers (i.e., performance of Toyota Camry 1998 comparing to a 1988 Ford Taurus - "general performance of those distributor, e.g., delivery schedule .etc."; from test drive, "those cars' performances are calculated based on test drive data"; and the column for new car section in a Washington Post newspaper always includes hypertext links for additional information about related subjects.

It would be obvious for one with ordinary skill in the art to implement Fogel et al.'s, Storey's idea, and Dudle et al. with old and well-known teachings as shown in the Official Notice because they are always available immediately to help a buyer in making decisions before online orderings.

11. Re. To claims 7, 13: These claims are directed containing similar limitations as in method claim 1, whether it is a system or a computer-program. Therefore, similar rationales and references set forth for claim 1's rejection are also used for a 35 USC 103(a) rejection.

12. Re. To claims 8, 14: These claims are directed containing similar limitations as in method claim 2, whether it is a system or a computer-program. Therefore, similar rationales and references set forth for claim 2's rejection are also used for a 35 USC 103(a) rejection.

13. Re. To claims 9, 15: These claims are directed containing similar limitations as in method claim 3, whether it is a system or a computer-program. Therefore, similar rationales and references set forth for claim 3's rejection are also used for a 35 USC 103(a) rejection.

14. Re. To claims 10, 16: These claims are directed containing similar limitations as in method claim 4, whether it is a system or a computer-program. Therefore, similar rationales and references set forth for claim 4's rejection are also used for a 35 USC 103(a) rejection.

15. Re. To claims 11, 17: These claims are directed containing similar limitations as in method claim 5, whether it is a system or a computer-program. Therefore, similar rationales and references set forth for claim 5's rejection are also used for a 35 USC 103(a) rejection.

16. Re. To claims 12, 18: These claims are directed containing similar limitations as in method claim 6, whether it is a system or a computer-program. Therefore, similar rationales and references set forth for claim 6's rejection are also used for a 35 USC 103(a) rejection.

Conclusion

17. Claims 1-18 are not patentable.

18. These references are also considered pertinent to applicants' disclosure:

- Numetrix, Ltd., "Numetrix Introduces Intelligent Visibility for Effective Supply Chain Management; Client Server Systems Improve Organizational Decision-Making Through Collaborative, Enterprise-Wide Integration", Business Wire, Dialog File 16:PROMT, Sep. 1995.

- Numetrix, Ltd., "Numetrix Announces the Release of its Intelligent Dynamic Distribution", Business Wire, Dialog File 16:PROMT, Oct. 1995.

- Greenbaum, Joshua M. "Efficient Consumer Response: How Software is Remaking the Consumer Packaged Goods Industry", Software Magazine, vol. 16, No. 6, p. 38, Jun. 1997.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Cuong H. Nguyen

CUONG H. NGUYEN
Primary Examiner
Art Unit 3625